

REMARKS

In this application, claims 37-43 and 48-85 are pending. Claims 1-36 and 44-47 were previously cancelled without prejudice to reconsideration in this or in a continuing application.

In the pending Office Action, Examiner Blanco made a restriction requirement between two identified groups of claims, which were characterized as follows:

- I. Claims 37-56, drawn to a spinal surgical instrument, classified in class 623, subclass 17.16.
- II. Claims 57-85, drawn to a spinal surgical system, classified in class 606, subclass 61.

The groups listed above are taken verbatim from the Office Action for the sake of clarity, and are not intended as an admission of any sort by Applicants as to the subject matter or classification of any claim.

As Examiner Blanco's restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per standard PTO practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the Examiner. Accordingly, Applicants elect group I (claims 37-43 and 48-56) for prosecution, with traverse on the grounds that searching and examining the entire application can be made without serious burden. Both sets of claims are drawn to a distracting instrument with an enlargeable portion. Accordingly, results of searching regarding one set will be relevant to the other, and vice-versa, because of their similarities in features. In fact, the searching for both sets of claims will likely be identical or at least overlap to a very great extent. Since the searching will overlap and produce references potentially relevant to both sets of claims, there will be no significant extra burden in searching and examining both sets of claims. Per MPEP 803 and

808.02, the restriction requirement should be withdrawn and all pending claims should be examined.

The pending Office Action also made a requirement for election of species. This requirement is also traversed. Examiner Blanco indicated the opinion that this application includes claims directed to more than one species “of the claimed invention.” Specifically, the following species were identified:

Species A: Figures 10a-10c

Species B: Figure 11a-11c

Species C: Figure 12a-12c

Species D: Figure 13a-13c

Species E: Figure 14a-140c

Species F: Figure 15a-15c

Species G: Figure 16a-16c

Species H: Figure 17a-17c

The listing above is taken from the Office Action, and is not intended as an admission of any sort by Applicants as to the subject matter of any claim or as to any embodiment disclosed in the application.

The Examiner relied on 35 U.S.C. § 121 in requesting that Applicant elect a single species. The Examiner added the opinion that no claims appeared generic.

Applicant elects species A, corresponding to FIGS. 10a-10c with traverse. At least claims 37-38, 41, 48-52, 57-66, 68-69, 73, 75-78, and 81-85, and perhaps others, are readable on the elected species. At least claims 37, 38, and 48-51 of the examiner’s group I, and perhaps other claims in the examiner’s group I or group II, are generic to all of the asserted species.

Applicants reserve the right to claim genericness of other claims later as may be appropriate. Further, examination of the claims with reference to all of the disclosed embodiments would not be burdensome, and would promote efficiency. Based on the existence of several generic claims and the lack of significant burden, Applicants respectfully request reconsideration of the election requirement.

In responding to the pending Office Action, amendments have been made to the claims regarding their numbering, pursuant to the Examiner's noting of a numbering irregularity. Applicants have not amended the substance of any claim, and do not intend to limit the scope of pending or later-offered claims. The claims in this application are intended to have their full scope, including equivalents, that may be available under the patent laws.

In conclusion, Applicants have provisionally elected claims 37-43 and 48-56 of this application, with traverse, in response to the present restriction requirement. Applicants also have provisionally elected species A, with traverse. It is respectfully requested that Examiner Blanco reconsider the present restriction and election requirements and withdraw them. An Office Action toward a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,



Christopher A. Brown, Reg. No. 41,642
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

4002-3449:CAB:345110